

Appln. No. 10/795,970
Amendment dated May 6, 2006
Reply to Office Action mailed February 6, 2006

REMARKS

Attorney for applicant has carefully reviewed the outstanding Office Action on the above-referenced application. Applicant has amended Claims 1, 4, 6, 7, 9-14, and 17, and has added new Claims 18-21.

Applicant's attorney is pleased to note that, at page 5 of the Office Action, the Examiner has indicated that Claims 7 and 8 contain allowable subject matter. By the foregoing amendments, Claim 7 has been rewritten in independent form to include all of the features recited in its base claim (i.e., original Claim 1) and its intervening claims (i.e., original Claims 2 and 3). In the foregoing circumstances, it is respectfully submitted that amended independent Claim 7 is in condition for allowance.

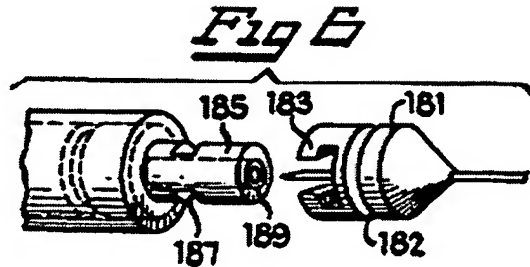
With respect to Claim 8, it depends directly from amended independent Claim 7. In such circumstances, it is believed that Claim 8 is also in condition for allowance.

The remaining claims (i.e., Claims 1-6 and 9-17) have been rejected on prior art grounds. More particularly, Claims 1-6, 9-11, 13-15, and 17 have been rejected under 35 U.S.C. 102(b) as being anticipated by Hajishoreh U.S. Patent No. 5,451,214. Claim 12 has been rejected under 103(a) as being unpatentable over the Hajishoreh reference in view of Mercado et al. U.S. Patent No. 5,540,665, while Claim 16 has been rejected under 103(a) as being unpatentable over the Hajishoreh reference in view of Kanda et al. U.S. Patent No. 6,780,188 B2. Applicant's attorney respectfully traverses the foregoing claim rejections for the following reasons.

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Initially, it is noted that Claim 1 has been amended in order to emphasize and clarify certain novel features of the present invention. More particularly, the present invention, as recited in amended independent Claim 1, relates to a safety syringe and cap holding device which includes a syringe having a body portion and a needle assembly interconnected with the body portion. The needle assembly includes a needle with an injection end and a hub. As recited in amended Claim 1, the safety syringe also includes a cover removably attached to the hub and covering the injection end of the needle, and a **cap holding device** having a receptacle for receiving the cover. Means are also provided in the cap holding device for disengaging the cover from the hub and **retaining the cover in the cap holding device** to allow the syringe and needle assembly to be withdrawn from the cap holding device **with the injection end of the needle uncovered** while the cover remains in the cap holding device.

It is respectfully submitted that the Hajishoreh reference does not anticipate or make obvious the present invention as recited in amended independent Claim 1. The Hajishoreh reference discloses a syringe apparatus which is significantly different from the novel safety syringe and cap holding device recited in amended Claim 1. Referring to the following reproduction of FIG. 6 of the Hajishoreh reference, the syringe apparatus depicted therein includes a needle retainer member 181 provided with a groove 182 for retaining a cap (shown in FIG. 13), and a syringe body having a coupling 185 and a needle ejector projection 189.



The Examiner's contention that Hajishoreh reference discloses a housing (the name of this element has been amended to a "cap holding device" in amended Claim 1) is incorrect, since the structure that the Examiner refers to as a housing is, in actuality, the needle retainer member 181. While the groove 182 of the needle retainer member 181 may be used to retain a cap, the groove 182 is integral with the needle retainer member 181 (i.e., the groove 182 is not a separate piece). In contrast, the safety syringe and cap holding device of the present invention includes a needle assembly and a separate cap holding device, as recited in amended Claim 1.

Even if it is assumed, for the sake of argument only, that the Hajishoreh reference discloses a cap holding device, the Hajishoreh reference does not disclose or suggest a mechanism in the cap holding device for disengaging the cover from the hub to allow the syringe and needle assembly to be withdrawn from the cap holding device with the injection end of the needle uncovered while the cover remains in the cap holding device, as recited in amended Claim 1. The Examiner contends that FIG. 6 of the Hajishoreh reference discloses the mechanism recited in amended Claim 1. The disengaging mechanism (i.e., the needle ejector projector 189) disclosed and shown in

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FIG. 6 of the Hajishoreh reference, however, simply serves to eject the used, disposable needle retainer member 181 from the syringe body and does not serve to disengage a cover from the hub to allow the syringe and needle assembly to be withdrawn from a cap holding device. In view of the distinctions discussed above, it is respectfully submitted that the safety syringe and cap holding device recited in amended independent Claim 1 is patentably distinguishable from the syringe apparatus disclosed in the Hajishoreh reference.

The Mercado et al. reference was only cited against dependent Claim 12, and is not believed to be relevant to the patentability of the safety syringe and cap holding device recited in amended Claim 1. For instance, the Mercado et al. reference relates to a gas generating engine for driving a dispensing device. The Mercado et al. reference does not disclose or suggest a safety syringe that includes a syringe, a cover, and a cap holding device, as recited in amended Claim 1. Applicant's attorney respectfully submits that the Mercado et al. reference, whether considered individually or in combination with the Hajishoreh reference, does not anticipate or make obvious the present invention as recited in amended independent Claim 1.

Accordingly, amended independent Claim 1 is believed to be in condition for allowance. Because Claims 2-6 and 9-12 depend from Claim 1, they are also believed to be in condition for allowance.

Amended independent Claim 13 recites a method of using a syringe. The method includes a step of providing a needle assembly including a hub, a needle, and a

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cover interconnected with the hub and covering the injection end of the needle. Other steps include engaging the needle assembly with a syringe body, and inserting the needle assembly into a **cap holding device**. The cap holding device is activated to **retain the cover** and permit the needle to be withdrawn from the cover with the injection end of the needle uncovered, **and the syringe is used**. Because the Hajishoreh reference does not teach or suggest the steps comprising applicant's claimed invention, amended Claim 13 is patentable over the Hajishoreh reference.

The Kanda et al. reference was only cited against dependent Claim 16, and is not believed to be relevant to the patentability of the method of using a syringe recited in amended Claim 13. For instance, the Kanda et al. reference discloses an irrigation/aspiration apparatus for ophthalmic surgery. There is no disclosure or suggestion in the Kanda et al. reference of the steps comprising applicant's claim invention. Applicant's attorney respectfully submits that the Kanda et al. reference, whether considered individually or in combination with the Hajishoreh reference, does not anticipate or make obvious the present invention as recited in amended independent Claim 1.

Accordingly, amended independent Claim 13 is believed to be in condition for allowance. Because Claims 14-17 depend from amended Claim 13, they are also believed to be in condition for allowance.

New Claims 18-21 have been inserted into this application by way of this Amendment. The present invention, as recited in independent Claim 18, relates to a cap holding device, which includes a housing having a receptacle for receiving a syringe and a

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cover. The cap holding device also includes a first means for releasing the cover from the syringe, and a second means for selectively retaining or releasing the cover from engagement within the housing. Because none of the cited references disclose or suggest the cap holding device recited in new Claim 18, it is respectfully submitted that new Claim 18 is patentable over the cited references. New Claims 19-21 depend, either directly or indirectly, from Claim 18, and therefore are also patentable over the cited references.

For the sake of good order, applicant's attorney notes that the submittal of this Amendment should not be construed as an admission that the Kanda et al. reference constitutes statutory prior art with respect to the present invention. More particularly, applicant's attorney notes that the Kanda et al. reference did not issue before the filing date of the present application and, as a result, it does not constitute statutory prior art under 35 U.S.C. 102(b).

In view of the foregoing amendments and remarks, applicant's attorney respectfully requests reexamination and allowance of pending Claims 1-17, and examination and allowance of new Claims 18-21. If such action cannot be taken, the Examiner is cordially invited to place a telephone call to applicant's attorney in order that any outstanding issue may be resolved without the issuance of a further Office Action.

A check for \$125 is enclosed to pay: (1) the \$100 examination fee for one independent claim in excess of three submitted for examination herein; and (2) the \$25 examination fee for one claim in excess of twenty submitted for examination herein. If there are any additional fees due as a result of this Amendment, including extension and

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petition fees, the Examiner is authorized to charge them to Deposit Account No. 503571.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Michael R. Friscia', written over the printed name.

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